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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,469	12/11/2000	Takeya Okamoto	ADACHI P134USP2	7448

20210 7590 03/01/2004

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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,469

Applicant(s)

OKAMOTO, TAKEYA

Examiner

Patrice Winder

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/232,862.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.7-8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No(s). 08/232,862, filed 04/25/1994; 08/555,400, filed 11/09/1995; 08/642,560 filed 05/03/1996; and 09/109,784 filed 07/02/1998. A reference to the prior application(s) must be inserted as the first sentence of the specification of this application. For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

2. It appears a reference to prior applications has been included in the first sentence of the specification in this application. However, the relationship of the all non-provisional applications included in this reference does not match the relationship in PTO records. Appropriate correction is required.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The priority date of the foreign application as recorded in the oath/declaration, paper#4 filed on March 26, 2001, does not match the priority date as recorded in the corrected filing receipt mailed on April 9, 2001.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,735,744.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the "means" omitted in the present application are an obvious variation of the claims of U.S. Patent No. 5,735,744.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7, 9-17, 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Neville et al., USPN 6,272,636 B1: (hereafter referred to as Neville).

8. Regarding claim 1, Neville taught a communication system for controlling use of program related element in a user system, the user system including a memory for storing the program related element, processor for executing a program or operating on data associated with the program related element and input devices and wherein a program related element includes at least one of a program, data or a combination of a program and data (column 5, lines 11-19, column 7, lines 2-15), the communication system comprising

in a user system, an access controller for generating requests for access to the program related element and for controlling access to the program related element (column 10, lines 30-38), and

in a host facility, a memory for storing an authorization key controlling access by the user system to the program related element (column 10, lines 46-50), and an associated access definition including a period of use definition defining a period in which the user system may access the program related element (column 13, lines 61-67), the host facility being responsive to a request for access to the program related element and to the associated access definition for communicating the authorization key

Art Unit: 2155

and at least parts of the associated access definition to the user system when requirements of the associated access definition are met (column 10, lines 62-67, column 13, lines 58-64), and

the access controller being responsive to the authorization key and the parts of the associated use definition for allowing the user system access to the program related element in conformance with the parts of the associated use definition (column 14, lines 2-9).

9. Regarding dependent claim 2, Neville taught the program related element is resident in the user system (column 7, lines 11-15).

10. Regarding dependent claim 3, Neville taught the program related element is loaded into the user system from a host system (column 7, lines 11-15).

11. Regarding dependent claim 4, Neville taught the program related element is transmitted into the user system from a second user system (column 7, lines 2-11).

12. Regarding dependent claim 5, Neville taught the program related element is a program (column 13, lines 12-14), the authorization key is an unlocking key (column 13, lines 25-27), and the access controller is responsive to the unlocking key for permitting access to the program related element (column 13, lines 27-31).

13. Regarding dependent claim 6, Neville taught the authorization key is a decryption key (column 5, lines 14-15, 24-27), the program related element is encrypted (column 5, lines 11-14), and the access controller include a decryption mechanism responsive to the decryption key to decrypt the program related element to provide the decrypted program related element to the user system (column 14, lines 6-9).

Art Unit: 2155

14. Regarding dependent claim 7, Neville taught the program related element is generated and encrypted in a second user system (column 10, lines 23-26), the program related element is transmitted to the user system (column 13, lines 8-13, and an authorization key and associated access definition corresponding to the program related element is generated and stored in the host facility in association with the generation and encryption of the program related element (column 10, lines 11-14, 42-46).

15. Regarding dependent claim 9, Neville taught the access definition includes at least one user period defining at least one corresponding access period during which the user system may access the program related element (column 13, lines 31-35) and wherein the access controller is responsive to an access period terminating access to the program related element at the expiration of the access period (column 9, lines 37-53).

16. Regarding dependent claim 10, Neville taught the access definition includes conditions to be satisfied before the user system may access the program related element (condition = within access period, column 13, lines 31-35).

17. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Cooper et al., USPN 5,757,907 (hereafter referred to as Cooper).

18. Regarding claim 21, Cooper taught a communication system for transmitting at least one of the program, the data, and a combination of the program and data from a host facility to a communication terminal device (column 9, lines 1-13), comprising:

an input device for inputting instructions to execute the program or to process the data (column 7, lines 19-25, column 10, lines 3-11);

storage means for storing the program, the data, or a combination of the program and data (column 9, lines 61-66);

executing means for executing the program stored in said storage means or executing data processing by using the data stored in said storage means, in accordance with instructions from said input device (column 9, lines 63-66);

clock means for keeping a predetermined time period after said executing means is allowed to execute the program stored in said storage means or to execute data processing by using the data stored in said storage means (column 9, lines 29-34, column 12, lines 30-34); and

interference means for interfering with execution of said executing means when said clock means counts said predetermined time period (column 9, lines 15-20, column 17, lines 52-56, column 18, lines 33-36).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 2155

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville in view of May et al., USPN 5,809,251 (hereafter referred to as May).

22. Regarding dependent claim 8, Neville does not specifically teach the access definition includes at least one of a start date/time and an end date/time defining a period in which access to the program related element is permitted. However, May taught access definition includes at least one of a start date/time and an end date/time defining a period in which access to the program related element is permitted (column 10, lines 22-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating May's end date in Neville's system for controlling digital product execution would have improved system effectiveness. The motivation would have been because May's end date would have been an equivalent mechanism of providing an access definition.

23. The language of claims 11-20 is substantially the same as previously rejected claims 1-10. Therefore, claims 11-20 are rejected on the same rationale as previously rejected claims 1-10.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

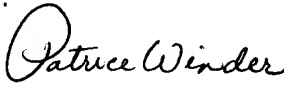
- a. Grantz et al., USPN 5,564,038: taught a method and apparatus for providing a trial period for a software license product using a date stamp and designated test period;
- b. Ronning, USPN 5,883,954: taught a self-launching software program that allows a user to sample the software program for a trial period; and
- c. Yoshida et al., USPN 6,075,862: taught a decryption key management scheme for a software distribution system utilizing a decryption key, which can enable re-install of the software that was decrypted once by a proper procedure.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-3662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2155

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2155

plw